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PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			COLBERT, ELLA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/695,684

Applicant(s)

KARI ET AL.

Examiner

Ella Colbert

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/21/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-23 are pending. Claims 1, 3-6, 8-10, 12, and 14-23 have been amended in this communication filed 2/06/07 entered as Response After Non-Final Action.
2. The IDS filed 3/21/07 has been reviewed and entered.
3. The 35 USC 112 First Paragraph Rejections are hereby withdrawn.
4. The 35 USC 112 Second Paragraph Rejections have been overcome in part by Applicants' amendment to the claims 3-6, 8, 10, 14-22 and is hereby withdrawn in part. There are still remaining 35 USC 112 Second Paragraph issues as set forth here below.
5. The 35 USC 101 Rejection is hereby withdrawn in view of the clarification of the statutory class and from the Applicants' amendments to the claims.

Specification

6. The Specification is objected to because The first line of each paragraph should be indented, page 1, lines 5 -7 should recite "mobile search terminal" and every place in the Specification where "search terminal" is discussed, and page 1, line 21 recites "(3, 4, 4', 4)". This line should recite "(3, 4, 4, and 4)". Page 6, lines 15 and 18 have a similar problem with "(3, 4, 4, and 4)". Also page 7, lines 35 and 36, page 9, lines 30, 32, 35, and 38; page 10, lines 4, 13, and 21; page 16, lines 8, 9, 13, 17, and 18; page 17, lines 10, 18, and 36; page 18, line 15; page 21, line 31; page 22, lines 14, 26, 33, and 36; page 23, lines 7, 9, and 12; page 27, lines 3, 18, and 23; page 28, lines 27 and 28; and page 29, lines 1, 9, and 14 have a similar problem. Page 3, line 19 recites "use. Further, the mobile station ...". This line should recite "user. Further, the mobile station

...". Page 3, line 37, recites "matically informed of the services ... during the". This line should recite "matically informed of the services ... during". Page 20, line 13 recites "http://www.isi.come/query? ...". This line should recite "www.isi.come/query? ...".
Correction is required. See MPEP § 608.01(b).

Abstract

7. The abstract of the disclosure is objected to because the abstract needs to be indented beginning with the first line and in lines 11 and 12 recite (3, 4, 4', 4"). This should recite (3, 4, 4, and 4). Correction is required. See MPEP § 608.01(b).

Title

8. The title of the invention is objected to because the title should recite as follows: -
- A METHOD AND SYSTEM FOR THE TRANSMISSION OF INFORMATION TO A MOBILE USER --.

Claim Objections

9. Claims 1 and 12 are objected to because of the following informalities: The claims need a semicolon (;) at the end of each claim limitation. Claims 8, 9, 11, 19, and 21 recite "data base". Do Applicants' mean "database"? Claim 10, page 4 recites "receiving and processing of the information query, and transmitting at least part of the". This line would be better recited as "receiving and processing the information query and transmitting at least part of the". Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 5, 11-13, 16, 18, 19, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, selecting a remote server among one or several remote servers ...". This line should recite "selecting at least one remote server from among several remote servers ...". Claim 12 has a similar problem.

Claim 11, recites "... service-specific information in at least one service database, and retrieving information from service databases". This line is unclear as written. This line should be written as "... service-specific information in at least one service database, and retrieving information from the at least one service database".

Claims 5, 12, 16, 18, 19, and 21 contain a "wherein" clause and a "adapted to" clause. Specifically, claim 5 the claim limitation reciting "wherein the method further comprises ...". Claim 13 recites "browser application program adapted to display the received information to the mobile". Claims 16, 18, and 21 have a similar problem with "wherein" and "adapted to" clauses.

The Examiner considers these limitations to only recite what is expected to happen, a desired result, or an intended use. The MPEP discusses a type of limitation in reference to "wherein" clauses and "adapted to" clauses. MPEP § 2111.04 states:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not

exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-8 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over "WalkNavi: A Location Aware Interactive Navigation/Guidance System", hereafter "WalkNavi" in view of (US 5,848,373) DeLorme et al, hereafter DeLorme.

As per claim 1, WalkNavi discloses, Method for transmission of information to a mobile user, said method comprising: sending, from a mobile search terminal, an information query including at least the current location or travel route for information to retrieved by using a browser application program running in the search terminal (Reference 1 (3.4) Page 1, paragraph 1- The HTML file and web page indicates a browser is present); receiving and processing the information query by a connection server (Page 1, paragraph 2-Page 2, paragraph 1), searching for information from the

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selected remote server(Page 2, paragraph 3-Page 3, line 1), transmitting the information to the search terminal (Page 3, paragraph 2, Page 4, paragraph 2-Page 5, paragraph 1), receiving and displaying the information to the user by the mobile search terminal (Page 4, paragraph 2-Page 4, line 2, Page 4, paragraph 2 –Page 5, paragraph 1). WalkNavi failed to disclose, selecting a remote server from among one or several remote servers available for the information query on the basis of the current location or travel route of the mobile user; routing the information query sent by the mobile search terminal to the selected server; receiving and displaying the information to the user by the mobile search terminal. DeLorme discloses, selecting a remote server from among one or several remote servers available for the information query on the basis of the current location or travel route of the mobile user (col. 15, lines 5-20); routing the information query sent by the mobile search terminal to the selected server (col. 15, lines 20-23 and col. 22, lines 50-60); receiving and displaying the information to the user by the mobile search terminal (col. 16, lines 34-38 and lines 39-42 and Fig. 3).

DeLorme failed to disclose a server. WalkNavi discloses a server in col. 20, line 52 and fig. 4 (93). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify WalkNavi with the discloser of Delorme because such a modification would allow WalkNavi to have spatially related information that can be queried from databases relevant to the selected travel route.

As per claim 2, WalkNavi discloses, Method according to Claim 1, further comprising displaying the received information to the user by said browser application program (Page 1, Paragraphs 1 and 2).

As per claim 3, WalkNavi discloses, Method according to Claim 1, further comprising, using at least two data transmission channels to transmit the information query from the search terminal (Page 1, paragraph 3-Page 2, paragraph 2 and paragraph 3).

As per claim 4, WalkNavi discloses, Method according to Claim 1, further comprising, including the information to be transmitted to the search terminal in a reply message as a response to the information query, and using at least two data transmission channels to transmit the reply message to the search terminal (Page 3, paragraph 2, Page 4, paragraph 2).

As per claim 5, WalkNavi discloses, method according to Claim 4, further comprising examining by the connection server the amount of information which will be needed to transmit the reply message to the search terminal, wherein the method further comprises selecting by the connection server the most appropriate data transmission method of said at least two data transmission channels to transmit the reply message to the search terminal (Page 4, paragraph 2 –Page 5, paragraph 1).

As per claim 6, WalkNavi discloses, Method according to Claim 1, further comprising transmitting at least part of the information between the search terminal and the means for receiving and processing of the information query by using short messages (Page 4, paragraph 3-Page 5, paragraph 1).

As per claim 7, WalkNavi discloses, Method according to Claim 6, further comprising displaying at least part of the received information to the user as short messages (Page 4, paragraph 1).

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As per claim 8, WalkNavi discloses, Method according to Claim 1, further comprising forming a data call between the search terminal and the means for receiving and processing of the information query, and transmitting at least part of the information transferred by using said data call (Page 1, paragraph 1 and paragraph 3-Page 2, paragraph 1).

As per claim 12, System claim 12 parallels the method steps of claim 1 and is rejected for the similar rationale as given for claim 1.

As per claim 13, this dependent claim is rejected for the similar rationale as given above for claim 2.

As per claim 14, this dependent claim is rejected for the similar rationale as given above for claim 3.

As per claim 15, this dependent claim is rejected for the similar rationale as given above for claim 3.

As per claim 16, this dependent claim is rejected for the similar rationale as given above for claim 6.

As per claim 17, this dependent claim is rejected for the similar rationale as given above for claim 7.

As per claim 18, this dependent claim is rejected for the similar rationale as given above for claim 8.

14. Claims 9-11 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over "WalkNavi: A Location Aware Interactive Navigation/Guidance

System", hereafter "WalkNavi" in view of (US 5,848,373) DeLorme et al, hereafter DeLorme. (US 5,754,787) Dedrick.

As per claim 9, WalkNavi and Delorme failed to disclose, further comprising storing user-specific information in at least one user profile data base and utilizing information in the user profile data base as an additional search criterion in the information search. Dedrick discloses, further comprising storing user-specific information in at least one user profile data base and utilizing information in the user profile data base as an additional search criterion in the information search (col. 6, lines 11-20 and col. 9, lines 1-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate in WalkNavi the disclosure of Dedrick because such an incorporation would allow WalkNavi to access the user profile data for a particular user stored in the profile database when needed.

As per claim 10, WalkNavi and DeLorme failed to disclose, comprising storing user-specific information in the mobile search terminal. Dedrick discloses, comprising storing user-specific information in the mobile search terminal (col. 8, lines 40-51).

As per claim 11, WalkNavi and Delorme failed to disclose, comprising storing service-specific information in at least one service data base, and retrieving information from service data bases. Dedrick discloses, comprising storing service-specific information in at least one service data base, and retrieving information from service data bases (col.9 , lines 45-col. 10, line 17).

As per claim 19, this dependent claim is rejected for the similar rationale as given above for claim 9.

As per claim 20, this dependent claim is rejected for the similar rationale as given for claim 10.

As per claim 21, This claim is rejected for the similar rationale as given above for claims 9 and 11.

As per claim 22, WalkNavi discloses, A system according to the Claim 12, further comprising at least one connection server and at least one remote server (Page 4, paragraph 3 –Page 5, paragraph 1) a device means for setting up a data transmission connection between the mobile search terminal and the connection server (Page 3, paragraph 2), and a device means for setting up a connection between the connection server and the remote servers (Page 3, paragraph 2-page 5, paragraph 1).

As per claim 23, WalkNavi discloses, A system according to the Claim 12, further comprising wireless communication means for transmitting information at least partly in a wireless manner (page 3, paragraph 3 – Page 4, line 2).

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all of the claimed invention,

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as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rahman et al (US 6,167,250) disclosed a mobile subscriber registering with a subscriber service.

Inquiries

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 24, 2007


ELLA COLBERT
PRIMARY EXAMINER